

Appl. No. 10/624,017
Atty. Docket No. P-124C2
Response to Office Action June 6, 2005
Customer No. 27752

REMARKS

Claims 23-36 are pending in the present application. Claims 23-36 are rejected. Claim 23 has been amended. Support for the amendment is found at page 3, lines 1-5 of the specification. It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Claims 27, 28, and 34 are objected.

ALLOWABLE CLAIMS

Claims 27, 28 and 34 stand are objected to, it is Applicants' understanding that Claims 27, 28 and 34 would be allowable over the cited reference if placed in independent form.

The Rejection Under 35 USC § 102(a) and 102(e)

Claims 23-26, 30-33 and 36 are rejected under 35 USC § 102(a) and 102(e) as being anticipated by Reinhart et al. US 5,965,175. The Examiner states that Reinhart et al. discloses methods for increasing colonic blood flow in animals, the method comprising feeding an animal a composition comprising a pet food formula and 1-11% fermentable fibers. The Examiner conceded that Reinhart et al. does not teach that the method is effective for controlling fecal hair excretion and trichobezoar formation. Applicants respectfully traverse the Examiner's rejection on the basis of the comments below.

Under § 102, anticipation requires that all the claim elements appear in a single prior art document. "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 citing *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2D 1051, 1053 (Fed. Cir. 1987). "The Identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2D 1913, 1920 (Fed. Cir. 1989).

Reinhart et al. teaches a pet food product for promoting intestinal health in dogs by repartitioning nitrogen and increasing colonic blood flow in canines. Reinhart et al. does not teach or even suggest the use of the compositions described therein for the

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control of fecal hair excretion or trichobezoar formation, nor does the repartitioning of nitrogen in canines and fecal hair excretion / trichobezoar formation appear to bear any relation to each other. Additionally, Reinhart does not teach that the animal is a cat or a rabbit. Therefore, Reinhart et al. does not disclose each and every element of the present application; it cannot as a matter of law anticipate the present application.

Accordingly, Claims 23-26, 30-33 and 36 are novel over the prior art of record. Reconsideration and withdrawal of the rejection on this basis are requested.

The Rejection Under 35 USC § 102(e)

Claims 23-26, 30-33 and 36 are rejected under 35 USC § 102(e) as being anticipated by Sunvold et al. US 6,039,952. The Examiner states that Sunvold et al. discloses a method for improving clinical signs in an animal with renal disease, the method comprising feeding the animal a composition comprising about 10-32% crude protein, 8-20% fat, 3-25% total dietary fiber, and about 1-11% fermentable fibers. However, the Examiner conceded that Reinhart et al. does not teach that the method is effective for controlling fecal hair excretion and trichobezoar formation. Applicants respectfully traverse the Examiner's rejection on the basis of the comments below.

Under § 102, anticipation requires that all the claim elements appear in a single prior art document. "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 citing *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2D 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2D 1913, 1920 (Fed. Cir. 1989).

Sunvold et al. teaches a pet food product for improving clinical signs in animals suffering from renal disease. Sunvold et al. does not teach or even suggest the use of the compositions described therein for the control of fecal hair excretion or trichobezoar formation, nor do renal disease and fecal hair excretion / trichobezoar formation appear to bear any relation to each other. Additionally, Sunvold does not teach that the animal is a cat or a rabbit. Therefore, Sunvold et al. does not disclose each and every element of the present application; it cannot as a matter of law anticipate the present application.

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Accordingly, Claims 23-26, 30-33 and 36 are novel over the prior art of record. Reconsideration and withdrawal of the rejection on this basis are requested.

The Rejection Under 35 USC § 102(b)

Claims 23-26, 29-33 and 35-36 are rejected under 35 USC § 102(e) as being anticipated by Reinhart US 5,616,569. The Examiner states that Reinhart teaches a process for treating GI disorders in an animal, the process comprising feeding an animal a composition comprising about 30% crude protein, about 20% fat, about 10% total dietary fiber, and about 3-9% of a supplemental, fermentable fiber. However, the Examiner conceded that Reinhart does not teach that the method is effective for controlling fecal hair excretion and trichobezoar formation. Applicants respectfully traverse the Examiner's rejection on the basis of the comments below.

Under § 102, anticipation requires that all the claim elements appear in a single prior art document. "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 citing *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2D 1051, 1053 (Fed. Cir. 1987). "The Identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2D 1913, 1920 (Fed. Cir. 1989).

Reinhart relates to pet food products containing fermentable fibers for maintaining ameliorating chronic diarrhea in animals, thereby restoring normal gastrointestinal function. See Reinhart, Column 1, lines 34 – 37. Diarrhea is described as an increase in fecal water content with an accompanying increase in the frequency, fluidity or volume of bowel movements. See Reinhart, Column 1, lines 11 – 13. Reinhart does not teach or even suggest the use of the compositions described therein for the control of fecal hair excretion or trichobezoar formation, nor do diarrhea and fecal hair excretion / trichobezoar formation appear to bear any relation to each other. Additionally, Reinhart does not teach that the animal is a cat or a rabbit. Therefore, Reinhart does not disclose each and every element of the present application; it cannot as a matter of law anticipate the present application.

Accordingly, Claims 23-26, 29-33 and 35-36 are novel over the prior art of record. Reconsideration and withdrawal of the rejection on this basis are requested.

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Rejection Under 35 USC 103(a) Over Reinhart et al. US 5,965,175

Claim 36 has been rejected under 35 USC 103(a) as being unpatentable over Reinhart et al. US 5,965,175. Specifically, the Examiner states that Reinhart et al. discloses methods for increasing colonic blood flow in animals, the method comprising feeding an animal a composition comprising a pet food formula and 1-11% fermentable fibers. However, the Examiner conceded that Reinhart does not teach that the method is effective for controlling fecal hair excretion and trichobezoar formation and that the method wherein 12% beet pulp is fed to the animal. Applicants respectfully traverse the Examiner's rejection on the basis of the comments below.

"The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion, or reason' to combine cited references." See *McGinley v. Franklin Sports, Inc.*, 262 F. 3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001). "Determinations of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit parameters." See *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998).

Reinhart et al., while disclosing a method for increasing colonic blood flow in animals, the method comprising feeding an animal a composition comprising a pet food formula and 1-11% fermentable fibers, does not teach or suggest a process effective for controlling fecal hair excretion and trichobezoar formation or that the animal is a cat or a rabbit.

The Examiner states that the rejected claims are obvious in view of Reinhart et al. because Reinhart et al. suggests the increasing colonic blood flow in animals and that by practicing Reinhart et al., one would be inherently practicing the claimed method of controlling fecal hair excretion and trichobezoar formation. Respectfully, the Examiner's rationale is flawed. Indeed, the Examiner's reference to inherency is misplaced since the rejected claims are directed to a new use for a composition, wherein such new use is directed to a process effective for controlling fecal hair excretion and trichobezoar formation. One of ordinary skill in the art would have failed to recognize the new use in animals, specifically, rabbits or cats, based on Reinhart et al.

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In order to establish inherency, extrinsic data must prove that: 1) the inherent property is necessarily present in the reference; and 2) that this would have been recognized by one of ordinary skill in the art. *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). This test, established by the Court of Appeals for the Federal Circuit, is not met in view of Reinhart et al.

With regard to the first requirement necessary for the Examiner to establish inherency, Reinhart et al. fails to show or even suggest that the alleged inherent property (process effective for controlling fecal hair excretion and trichobezoar formation) is necessarily present based on the Reinhart et al. disclosure. For example, Reinhart et al. merely teaches the use of a pet food product for promoting intestinal health in dogs by repartitioning nitrogen and increasing colonic blood flow in canines. Moreover, Reinhart et al. merely reports differences of oxidation of butyrate by canine intestinal cells, oxidation of glucose by canine intestinal cells, reduction of colonic histopathologies, increase the weight of colonic tissue or epithelial. There is absolutely no teaching or suggestion that relates to effectively controlling fecal hair excretion and trichobezoar formation. Rather, Reinhart et al. merely reports that inclusion of dietary fiber in specific diets can result in the repartitioning nitrogen and increasing colonic blood flow in canines.

As such, Reinhart et al. fails to meet the first criteria for establishing inherency of Applicants' claims directed to the process effective for controlling fecal hair excretion and trichobezoar formation. The necessary showing, that being a showing of process effective for controlling fecal hair excretion and trichobezoar formation, is not necessarily present in results provided by Reinhart et al.

With regard to the second requirement necessary for the Examiner to establish inherency, one of ordinary skill in the art would have failed to recognize that certain compositions disclosed by Reinhart et al. could be successfully utilized to effectively control fecal hair excretion and trichobezoar formation. Reinhart et al. merely discloses that feeding fermentable fibers to dogs aids in removing nitrogen from the blood of dogs, to enhance blood flow to colonic tissues, and to enhance metabolic fuel availability to canine intestinal cells. This provides an increase in quantity of bacteria in the colon. See Column 2, lines 61-67 and Column 3, lines 1-4. One of ordinary skill could not have

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known that a composition comprising fermentable fibers could be successfully utilized to effectively control fecal hair excretion and trichobezoar formation in rabbits or cats.

It is particularly important to note that the present invention is directed to animals such as cats and rabbits. Accordingly, it would have been antithetical to equate the use of pet food product for promoting intestinal health in dogs by repartitioning nitrogen and increasing colonic blood flow in canines (as in Reinhart et al.) with the process effective for controlling fecal hair excretion and trichobezoar formation (as set forth in Applicants' claims). For these reasons, the Examiner cannot state that it would have been obvious to arrive at Applicants' invention using Reinhart et al. Indeed, respectfully, the Examiner appears to be using impermissible hindsight in this regard.

As such, provided with Reinhart et al., one of ordinary skill in the art would fail to deduce that use of the composition specified in Applicants' claims, would result in the process effective for controlling fecal hair excretion and trichobezoar formation.

In view of the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 103(a) because the claims as submitted herein would not have been obvious in view of Reinhart et al.

Rejection Under 35 USC 103(a) Over Sunvold et al. US 6,039,952

Claims 33 and 36 have been rejected under 35 USC §103(a) as being unpatentable over Sunvold et al. US 6,039,952. This rejection is traversed because Sunvold et al. US 6,039,952 is not available as prior art against the present application under 35 USC §103(c).

Sunvold et al. US 6,039,952 only qualifies as prior art under 35 USC §102(e). The present application and Sunvold et al. US 6,039,952 were, at the time the claimed invention was made, owned by, or subject to an obligation of assignment to, The Iams Company.

Therefore, since the current application has a filing date after November 29, 1999 (the effective date of 35 USC §103(c)), It is contended that Sunvold et al. US 6,039,952 is not available as a reference under 35 USC §103(c).

However the examiner states that Applicant's have not provided the required statements and cites MPEP 706.02(1) (2). The Applicant's take exception to this conclusion by the Examiner, specifically, under MPEP 706.02(1)(2) Section entitled

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Evidence Required to Establish Common Ownership states "if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person" this is sufficient evidence to establish common ownership to the same person or organizations. The Examiner is directed to the underlined portion above. Applicants have met the burden stated in MPEP 706.02(1)(2) and Sunvold et al. 6,039,952 is not available as prior art against the present application under 35 USC §103(c).

Rejection Under 35 USC 103(a) Over Reinhart US 5,616,569

Claim 32-33 and 35-36 have been rejected under 35 USC 103(a) as being unpatentable over Reinhart US 5,616,569. Specifically, the Examiner states that Reinhart teaches a process for treating GI disorders in an animal, the process comprising feeding an animal a composition comprising about 30% crude protein, about 20% fat, about 10% total dietary fiber, and about 3-9% of a supplemental, fermentable fiber. However, the Examiner conceded that Reinhart does not teach that the method is effective for controlling fecal hair excretion and trichobezoar formation. Additionally, the Examiner concedes that Reinhart does not specifically teach that the claimed amounts of supplemental fibers are fed to animals. Applicants respectfully traverse the Examiner's rejection on the basis of the comments below.

"The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some 'teaching, suggestion, or reason' to combine cited references." See *McGinley v. Franklin Sports, Inc.*, 262 F. 3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001). "Determinations of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit parameters." See *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998).

Reinhart, while disclosing a pet food product containing fermentable fibers for maintaining ameliorating chronic diarrhea in animals, thereby restoring normal gastrointestinal function, does not teach or suggest a process effective for controlling fecal hair excretion and trichobezoar formation in cats or rabbits.

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The Examiner states that the rejected claims are obvious in view of Reinhart because Reinhart suggests a process for treating GI disorders in animals and that by practicing Reinhart, one would be inherently practicing the claimed method of controlling fecal hair excretion and trichobezoar formation. Respectfully, the Examiner's rationale is flawed. Indeed, the Examiner's reference to inherency is misplaced since the rejected claims are directed to a new use for a composition, wherein such new use is directed to a process effective for controlling fecal hair excretion and trichobezoar formation. One of ordinary skill in the art would have failed to recognize the new use in animals, specifically, cats or rabbits based on Reinhart.

In order to establish inherency, extrinsic data must prove that: 1) the inherent property is necessarily present in the reference; and 2) that this would have been recognized by one of ordinary skill in the art. *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). This test, established by the Court of Appeals for the Federal Circuit, is not met in view of Reinhart.

With regard to the first requirement necessary for the Examiner to establish inherency, Reinhart fails to show or even suggest that the alleged inherent property (process effective for controlling fecal hair excretion and trichobezoar formation) is necessarily present based on the Reinhart disclosure. For example, Reinhart merely teaches the use of a pet food product for alleviating GI disorders by supplying a fermentable fiber source which provides the GI tract with a preferred energy source to restore natural GI function. Moreover, Reinhart merely reports the fermentability and organic matter disappearance of fibrous substrates by fecal microflora and the occurrence of GI disorders depending on the dietary fibers present. There is absolutely no teaching or suggestion that relates to effectively controlling fecal hair excretion and trichobezoar formation in rabbits or cats. Rather, Reinhart merely reports that inclusion of dietary fiber in specific diets can result to relieve symptoms of chronic diarrhea by "feeding" the cells which line the GI tract of the animal. See Column 1, lines 44-46.

As such, Reinhart fails to meet the first criteria for establishing inherency of Applicants' claims directed to the process effective for controlling fecal hair excretion and trichobezoar formation. The necessary showing, that being a showing of process

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effective for controlling fecal hair excretion and trichobezoar formation, is not necessarily present in results provided by Reinhart.

With regard to the second requirement necessary for the Examiner to establish inherency, one of ordinary skill in the art would have failed to recognize that certain compositions disclosed by Reinhart could be successfully utilized to effectively control fecal hair excretion and trichobezoar formation. Reinhart merely discloses that that inclusion of dietary fiber in specific diets can result to relieve symptoms of chronic diarrhea by "feeding" the cells which line the GI tract of the animal. See Column 1, lines 44-46. One of ordinary skill could not have known that a composition comprising fermentable fibers could be successfully utilized to effectively control fecal hair excretion and trichobezoar formation in cats or rabbits.

It is particularly important to note that the present invention is directed to animals such as cats and rabbits. Accordingly, it would have been antithetical to equate the use of a pet food product for alleviating GI disorders by supplying a fermentable fiber source which provides the GI tract with a preferred energy source to restore natural GI function (as in Reinhart) with the process effective or controlling fecal hair excretion and trichobezoar formation (as set forth in Applicants' claims). For these reasons, the Examiner cannot state that it would have been obvious to arrive at Applicants' invention using Reinhart. Indeed, respectfully, the Examiner appears to be using impermissible hindsight in this regard.

As such, provided with Reinhart, one of ordinary skill in the art would fail to deduce that use of the composition specified in Applicants' claims, would result in the process effective for controlling fecal hair excretion and trichobezoar formation.

In view of the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 103(a) because the claims as submitted herein would not have been obvious in view of Reinhart.

CONCLUSION

In light of the remarks and amendments presented herein, Applicants respectfully submit Claims 23-36 are allowable over the cited references. Reconsideration and allowance are respectfully requested. In the event that issues remain prior to allowance

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of the noted claims, then the Examiner is invited to call Applicant's undersigned attorney for further discussion.

Respectfully Submitted,

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July 29, 2005
Customer No. 27752